

HON et al. U.S. Patent Appln. 10/796,291  
Attorney Docket No.: 081468-0308639

- Amendment -

### REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the Office Action dated November 23, 2005, the Examiner rejected claims 1-5, 9-13, and 17-18, under 35 USC §103(a), as allegedly being unpatentable over EP '222 (E.P. 1 286 222) in view of EP '088 (E.P. 2003088088).

The Examiner objected to claims 6-8 and 14-16 without any indication as to the basis of the objections. Applicant submits that this renders the outstanding Office Action as incomplete.

Claims 1-9 are currently presented for examination of which claims 1, 9, and 17 are the sole independent claims.

Applicants respectfully traverse the prior art rejections, under 35 U.S.C. §103(a), for the following reasons:

#### I. Prior Art Rejections Under 35 U.S.C. §103(a).

Independent claim 1 positively recites that the magnetic element extends substantially between outer portions of the first and second magnet system subassemblies. These features are amply supported by the embodiments described in the Specification. (*See, e.g.*, Specification: par. [0051], FIG. 2). For example, the disclosed embodiments provide that actuator 200 comprises a second actuator subassembly 202 that is movable relative to a first actuator subassembly 201 and that the second actuator assembly 202 comprises an electrically conductive element, such as a coil. (*See, e.g.*, Specification: par. [0048] - [0049], FIG. 2). For purposes of illustration, the first actuator subassembly 201 remains relatively still as the second actuator assembly 202 (*e.g.*, coil) moves into, and out of, the plane of the page (*see, e.g.*, FIG. 2).

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The disclosed embodiments further provide that actuator 200 further comprises a back mass 207a, 207b, such as a back iron, and magnetic elements 208a, 208b, which extend between the outer edges of the first 203 and the second 204 magnet system subassemblies. (See, e.g., Specification: par. [0051], FIG. 2). That is, the magnetic elements 208a, 208b protrude from the sides of the magnet system subassemblies 203, 204, but do not laterally surround the subassemblies 203, 204, as doing so would prevent the second actuator assembly 202 from moving into, and out of, the plane of the page.

In contrast to the Examiner's assertions, the EP '088 reference fails to teach or suggest the combination of features recited in claim 1. In particular, EP '088 specifically discloses that shield 22, which the Examiner alleges corresponds to the claimed magnetic element, *surrounds all side faces* except for the upper and lower faces of the yoke 1. (See, e.g., EP '088: Abstract; and par. [0023]). In so doing, the EP '088 reference clearly fails to teach or suggest that the magnetic element extends substantially between outer portions of the first and second magnet system subassemblies, as required by claim 1.

Moreover, with respect to the combination of the EP '088 and EP '222 references, Applicants submit that there is absolutely no suggestion in either of the references to combine the features of both to render independent claim unpatentable. In fact, the actuator of EP '222 appears to have a configuration in which, like the present invention, the actuator moves into, and out of the plane of the page. As such, the shield 22 configuration of EP '088 could not be combined with the actuator of EP '222. Given the disparate configurations of EP '088 and EP '222, the respective configurations are clearly incompatible. As such, it is an unreasonable leap of faith to assert that it would be obvious to artisans of ordinary skill to combine the features of configurations of EP '088 and EP '222 to reach the claimed invention. Such an assertion could only be justified by impermissible hindsight.

For at least this reasons, Applicants submit that the EP '088 and EP '222 references, whether taken alone or in combination, do not, in any way, teach the